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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,991	02/25/2004	Martin James Sugden	13651-4	9797

1059 7590 02/02/2005

BERESKIN AND PARR  
SCOTIA PLAZA  
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CANADA

EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,991	<b>Applicant(s)</b> SUGDEN, MARTIN JAMES	
	<b>Examiner</b> Steven Wong	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/02/04; 06/02/04</u> | 6) <input type="checkbox"/> Other: ____  |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (5,992,850) in view of Harbaugh, Miller, Paulos or "Puzzles: Old & New: How to Make and Solve Them" (Puzzles). Regarding claim 1, Li discloses that it is old and well known in the art of puzzles to provide a manipulable puzzle comprising a centrally positioned interior connecting element (1) and 26 cubic elements (2, 3, 4) rotatable about the connecting element. Li also states that it is well known to provide the faces of the cubic elements with colors to form various patterns on the surface of the cube faces and to solve the puzzle by arranging the cubic elements to provide a single color on each face of the puzzle. However, Li lacks the teaching for a given cubic element to comprise the same color on each of its exposed faces so as to form a particular pattern for the cube in its solved state.

Harbaugh, Miller, Paulos and Puzzles all disclose that it is well known in the art of manipulable puzzles to provide various indicia to the faces of the cubes in order to have the user form a particular design as the designated solution. Puzzles teaches numerous indicia for the manipulable puzzles to provide various pattern solutions. The particular designation that the cubic elements have the same color on their exposed faces is considered to be obvious given the teachings of Harbaugh, Miller, Paulos and Puzzles that it is well known to modify the indicia of manipulable puzzles for a particular design purpose. The differences between applicant's indicia

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and that of the prior art reside in the meaning and information conveyed by the indicia and such differences are not considered patentable unless applicant can demonstrate a new and unobvious relationship between the indicia and the substrate. See *In re Gulack* CAFC 217 USPQ 401; *In re Reeves* 20 C.C.P.A. 767, 62F.2d 199; *In re Russell* 18 C.C.P.A. 1184, 48F.2d 668; *In re Sterling* 21 C.C.P.A. 1134, 70F. 2d 910. Thus, it would have been obvious to one of ordinary skill in the art to provide the puzzle of Li with the same color on the exposed faces of each of the cubic elements in order to provide a particular pattern for the solution of the puzzle.

Regarding claim 2, Li states that it is well known in the art to arrange the indicia such that one color may be provided on each surface.

Regarding claim 3, Li teaches a plurality of colors are well known for the puzzle.

Regarding claims 4 and 7, Li states that 3x3x3 cubes comprising 26 elements are well known in the art.

Regarding claims 5, 6 and 10-12, note the rejection of claim 1 as the particular patterns are considered to be obvious given the teachings of Li in view of Harbaugh, Miller, Paulos and Puzzles.

Regarding claims 8 and 9, it would have been obvious to one of ordinary skill in the art to form the puzzle pieces of Li from injection molded plastic in order to take advantage of that material's well known physical characteristics.

Regarding claim 13, note the rejections of claims 1-4 above.

Regarding claims 14-18, note the rejections of claims 5, 6 and 10-12 above.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. D495,378 in view of Li.

D495,378 discloses a manipulable puzzle cube comprising a plurality of cubic elements, the elements appearing to have exposed faces with the same pattern thereon. It would have been obvious to one of ordinary skill in the art to provide the puzzle of D495,378 with the interior connecting element of Li in order to permit rotation and movement of the cubic elements for rearrangement purposes. The particular recitations for the decorative patterns of the puzzle pieces is considered to be obvious given the teachings of Sugden and the case law citations set forth above.

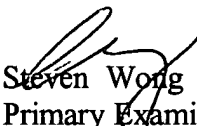
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
February 1, 2005